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EXAMINER

WILLIAMS, JAMILA O

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/711,194
Filing Date: November 13, 2000
Appellant(s): NORMAN ET AL.

MAILED
OCT 18 2007
Group 3700

T. Daniel Christenbury
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6-27-2007 appealing from the Office action mailed 5-17-2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appellants filed a Notice of Appeal on July 12, 2005 for U.S. Patent Application Serial No. 09/844,322 filed on April 2, 2001. An official Action dated March 28, 2006 reopened prosecution in that application. The Appeal is being reinstituted in that application.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,944,368	O'BRIAN et al.	7-1960
5,607,339	KRAMER	3-1997

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5,913,708	GROSS	6-1999
4,294,036	WION	10-1981
4,063,402	WASHBURN et al.	12-1977
09/844,322	Casey William Norman et al.	4-2001

Merrian-Webster's Collegiate Dictionary Tenth Edition

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,4-7,13-16,18, 20,21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-21,28-29,31,33-36,38-39,41-42,44 of copending Application No. 09/844322. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are similar in scope and subject matter.

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For example, claim 1 of '322 discloses a garment comprising flexible and elastic injection molded thermoplastic elastomer having a molded shape to fit over in a life-like way external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accomidates passage of a doll's head or limb(s) and a wall thickness from 1 to 3mm. However claim 1 is lacking a seamless doll's skin and the material repeatedly covers and is removed from the doll. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material of '322 a skin for the purpose of altering the doll and to make the material repeatedly removable for the purpose of allowing the user to interchange the appearance of the doll.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,6-8,10,13,14,15,16,20,21 are rejected under 35 U.S.C. 103(a) as being obvious over O'Brian et al [2,944,368], hereinafter O'Brian in view of Kramer [5,607,339] and either Gross [5,913,708] or Wion [4,294,036] and further in view of Washburn et al [4,063,402], hereinafter Washburn.

O'Brian discloses in Figs 1-7, a garment or skin [blouse 30] comprising a flexible and elastic molded thermoplastic elastomer [col 3 lines 54-56 and col 4 line 58 and also [[re-sil-ient (rî-zîl'yent) *adjective* 1. Capable of returning to an original shape or position, as after having been compressed.] according to Merrian-Webster's Collegiate Dictionary Tenth Edition] doll's garment having a molded shape to fit over external surfaces of at least a portion of a doll [Fig 4], has a through hole [insofar as the applicant has claimed blouse 30 is considered to have a through hole [the opening for the neck for example]. Additionally, please note that O'Brian start with a flat sheet of material, which is then formed into three-dimension article.

Regarding the limitations of the skin or garment being adapted in size to be fitted to and removed from a doll having a specific height (less than 8cm or above 8cm to about 20cm), the garment of O'Brian is inherently capable of this function.

O'Brian does not disclose a doll having articulated limbs, having a doll with a height range of 8-20cm, as recited in claim 15; a doll's garment formed from a flexible sheet of polymer plastic material between 1mm and 3 mm in thickness, as recited in claim 1; a modulus of elasticity of 120-350KN/m²), as recited in claim 6.

Kramer teaches the concept of providing a doll, a doll's garment or skin (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 1mm and 3 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (120-350KN/m²). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the doll's garment of O'Brian to have thickness and with modulus of elasticity as taught by Kramer to provide more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of O'Brian with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more realistic and enjoyable for the children to play with.

Washburn teaches that it is conventional to have dolls at a height of 4.5in (approx. 11cm). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified device of O'Brian with the articulated doll as taught by Gross or Wion with the height as taught by Washburn for the purpose of providing a more user friendly doll for a young child.

With respect to the injection molded thermoplastic elastomer in claims 21-22, is considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims are treated in claims].

5. Claims 3-5,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian et al in view of Kramer and either Gross or Wion as applied above and further in view of Yasuda [5,928,803].

Modified device of O'Brian has most of the elements of these claims but for the specific elastomeric material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of O'Brian out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

6. Claims 12 are rejected under 35 U.S.C. 103(a) as being obvious over O'Brian et al [2,944,368], hereinafter O'Brian in view of Kramer [5,607,339] and either Gross [5,913,708] or Wion [4,294,036], as applied to claim 10 above and further in view of Fogarty et al [4,414,774], hereinafter Fogarty. O'Brian as modified by Kramer and either Gross or Wion disclose all elements of the claim but for the integrally molded detail. Fogarty teaches molded doll garments having integrally molded details (fig 4,9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an integrally molded feature of Fogarty with the modified garment or skin of O'Brian for the purpose of making the garment or skin more realistic.

7. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being obvious over Yasuda [5,928,803] in view of 5,607,339 to Kramer and further in view of O'Brian

et al [2,944,368], hereinafter O'Brian. Yasuda discloses a seamless doll's skin or garment (fig 1) comprising a seamless, molded elastomeric material (col 3 lines 18-54 of the specification) sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which repeatedly covers and is removed from the doll and transforms the doll into a different character or object (inherently capable of this function).

Yasuda does not however disclose the wall thickness of 1-3mm for the doll's skin nor the through hole to accommodate passage of a doll's head or limb(s).

Kramer teaches having seamless doll's skin with a wall thickness of 1-3mm.

O'Brian teaches having a through hole to accommodate passage of a doll's head (for example the opening for the neck/head in figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the wall thickness as taught by Kramer and the through hole as taught by O'Brian with the skin of Yasuda for the purpose of making a more realistic doll's skin. Regarding the limitation of claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda to form an animal since the material is disclosed to be used as fur of stuffed animal toys (col 19 line 62).

(10) Response to Argument

Rejections of claims 1,6-8,10,13-16,20, 21 under 35 U.S.C. 103(a) over O'Brian in view of Kramer and either Gross or Wion and further in view of Washburn.

Appellant's argument towards the material of O'Brian have been noted. However the examiner maintains that in that the material of O'Brian is resilient or capable of resuming its original shape after being expanded or compressed (as when the article of clothing is placed on the doll), the material is in fact an elastomeric.

It is noted on page 9 of the brief that applicant has defined "plastic" as the ability to be molded wherein "elastic" refers to being easily stretched, the examiner maintains that just as the material of appellant can be molded and stretched so can the material of O'Brian (the attaching of the clothes to the body requires stretching as shown in figure 5).

Additionally, Kramer shows elastomeric material used for doll clothing.

Regarding the recitation towards injection molding, this is considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims are treated in claims].

O'Brian discloses molded articles (figure 5 and 7 for example), The examiner maintains that there is no indication of the differences between the product of O'Brian and the product of the present invention. Both products result in seamless articles as claimed.

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Appellant's arguments towards the combination of O'Brian and Kramer have been noted. However the examiner maintains that both O'Brian and Kramer disclose doll clothing or skin. Providing the clothing of O'Brian with the thickness and modulus of Kramer's doll clothes would have been obvious to one having ordinary skill in the art. Regarding Appellant's argument towards the articles of O'Brian and Kramer fitting over the dolls in a life-like way, the examiner maintains that the orientation of the articles of O'Brian are fitted in a life-like way (figure 4-5). It is further noted that this recitation is not in the presently pending claims.

Regarding Appellant's arguments towards Gross, Wion and Washburn, the examiner maintains that they references are merely being provided to show dolls with articulated joints and doll sizes, using these dolls with the articles of O'Brian modified by Kramer would provide a more realistic and life-like toy.

Rejections of claims 3-5, 11 under 35 U.S.C. 103(a) over O'Brian in view of Kramer and either Gross or Wion and further in view of Yasuda.

Appellant's arguments towards O'Brian, Kramer and either Gross or Wion have been addressed above. The examiner maintains that Yasuda is being applied for the specific elastomeric material for doll clothes.

Rejection of Claim 12 under 35 U.S.C 103 (a) over O'Brian in view of Kramer and either Gross or Wion and further in view of Fogarty.

Appellant's arguments towards O'Brian, Kramer and either Gross or Wion have been addressed above. The examiner maintains that Fogarty is being provided for the teaching of having molded details on doll clothing.

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Rejections of claims 1,9 under 35 U.S.C. 103(a) over Yasuda in view of Kramer and further in view of O'Brian

Appellant's arguments towards the Yasuda reference have been noted. However the examiner maintains that Yasuda discloses thermoplastic elastomer material for doll clothes (col 3 ln 18-54 and col 19 ln 62-65) and using the material of Yasuda with the modified article of O'Brian or in view of O'Brian and Kramer would have been obvious to one having ordinary skill in the art since all references disclose clothes or skins for dolls. Regarding the argument towards Yasuda failing to disclose a through hole. The examiner maintains that Yasuda discloses elastomeric material for doll clothes or skins. O'Brian is being relied upon for the through hole in doll clothes.

Regarding the argument that Yasuda inherently has seams, the examiner maintains that the "seamless" skin disclosed/claimed has nothing to do with the internal structure of the material (as to not exclude the laminate of Yasuda).

Regarding the thickness of Yasuda, the examiner maintains that both Yasuda and Kramer disclose doll clothes, using the thickness of Kramer with the modified clothes of Yasuda would have been obvious.

Provisional Double Patenting Rejection

The issue regarding the timeliness of the double patent rejection has been considered however the rejection must be decided on its own merits. Appellant has provided no argument with respect to this rejection.

Additional Arguments Applicable to all claims

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Appellant's additional arguments with regards to commercial success refer to evidence attached in the Evidence Appendix but the Evidence Appendix clearly states "None". No declaration has been filed in this application. Absent a declaration in the present case, the examiner maintains the rejections of record.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

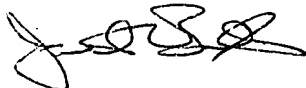
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